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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/581,271

08/31/2006

Stefan Gallinat

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EXAMINER

CLAYTOR, DEIRDRE RENEE

ART UNIT

PAPER NUMBER

1627

NOTIFICATION DATE

DELIVERY MODE

08/03/2011

ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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Office Action Summary	Application No. 10/581,271	Applicant(s) GALLINAT ET AL.
	Examiner Renee Claytor	Art Unit 1627

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 21 April 2011.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 14-30 and 32-43 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 14-30 and 32-43 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|------------------------------------------------------------------------------------------------------------|-----------------------------------------------------------------------------------------|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Response to Arguments

Applicants argue that neither the Max et al. (US PgPub 2005/0158350) or Tom Dieck et al. (US PgPub 2005/0037042) qualify as prior art. It is argued that Max was published on July 21, 2005, after the effective U.S. filing date of the instant application and Max was filed on October 18, 2004 which is after the priority date of the instant application (December 3, 2003, the filing date of German Patent Application No. 103 57 451.4). It is noted that Applicants have filed an English translation of the foreign priority document and priority goes to 12/03/2003 and the rejections over Max et al. and Tom Dieck et al. will be removed.

Accordingly, please see the new rejections below.

Claim Rejections – 35 U.S.C. § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 14-30, 32-43 rejected under 35 U.S.C. 103(a) as being unpatentable over Korte (US Patent 7,582,677) and Eggers et al. (WO 03/0070152) in view of Shibata et al. (Planta Med. 57 (1991) pages 221-224) and Matsukawa (US Patent 6,214,352).

Korte et al. teach topical formulations for cosmetic or pharmaceutical use that include a lignan esters such as matairesinol or arctigenin (Col. 3, lines 61-67). The

lignans such as matairesinol and arctigenin are present in the compositions in amounts ranging from 0.01-20% (see Examples 1-8). The lignans may be useful as active agents in topical preparations as anti-aging substances for treating signs of dermatological aging, both photoaging and intrinsic aging, including skin wrinkles such as fine wrinkling around the mouth area, irregular pigmentation, sallowness, loss of skin resilience and elasticity (Col. 4, lines 23-30). They may also be useful as anti-inflammatory agents or as skin cancer preventing agents (Col. 4, lines 31-32). Cosmetic or dermatological carriers would include water (taught in Examples 1-3, 5-6 and 8). Korte et al. teach compositions that include glycerin in amounts ranging from 5 to 80% (Examples 1, 2, 5, 8).

Eggers et al. (WO 03/070152) teaches a new anti-aging agent for cosmetic compositions that contains plant extracts containing *Arctium* (see page 1 of translation, paragraph 6). It is taught that one of the species of the genus *Arctium* Lappa is arctigenin and arctiin (see paragraph 7 on page 1 of translation). It is taught that the compositions are formulated as creams, gels, lotions and aqueous/alcoholic solutions, with the addition of auxiliaries and additives, which indicate that a cosmetically or dermatologically acceptable carrier is included in the composition (see fourth full paragraph on page 2 of the translation). It is taught that amounts of the plant extracts range from 0.001 to 1% (see paragraph 6 on page 1 of the translation).

Korte et al. and Eggers et al. do not teach that the 2,3-dibenzylbutyrolactone derivatives are in combination with licochalcone A.

Shibata et al. teach that licochalcone A has an anti-inflammatory effect in in vivo models of mouse-ear edema and papilloma on mouse back skin (see fourth paragraph in Introduction). Licochalcone A was shown to significantly inhibit mouse ear edema (see first paragraph of Results and Table 1). It is taught that licochalcone A is from the root of *Glycyrrhiza inflata* (see first paragraph of Introduction). Shibata et al. teach that 0.1-3.0 mg of licochalcone was administered to each ear (see Table 1).

Matsukawa teaches cosmetic compositions that include licochalcone A as a whitening agent (see Col. 3, lines 11-17). Among alcohols that can be included in the composition are glycerin (Col. 4, lines 10-11).

Accordingly, it would be obvious to a person of ordinary skill in the art at the time of the invention to combine the teachings of Shibata et al., which teaches cosmetic compositions comprising licochalcone A as an anti-inflammatory agent and Matsukawa which teaches cosmetic compositions that comprise licochalcone A as a whitening agent, with the teachings of Eggers et al. which teaches arctigenin and arctiin as cosmetic agents used for anti-aging. One would be motivated to combine the above references because it is prima facie obvious to combine two compositions each of which is taught by the prior art to be useful for the same purpose, in order to form a third composition to be used for the very same purpose. The idea of combining them flows logically from their having been individually taught in the prior art. In re Kerkhoven, 626 F.2d 846, 205 USPQ 1069, 1072 (CCPA 1980).

Furthermore, it is obvious to vary and/or optimize the amount of component (a), component (b) and component (c) provided in the composition, according to the

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guidance provided by Shibata et al., Matsukawa and Eggers et al., to provide a composition having the desired properties such as the desired ratios and concentrations of component (a) and component (b) in an effort to provide maximal cosmetic effects.

It is noted that “[W]here the general conditions of a claim are disclosed in the prior art, it is not inventive to discover the optimum or workable ranges by routine experimentation.”

In re Aller, 220 F.2d 454, 456, 105 USPQ 233, 235 (CCPA 1955).

Contact Information

No claims are allowed.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Renee Claytor whose telephone number is (571)272-8394. The examiner can normally be reached on M-F 8:00-4:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Sreeni Padmanabhan can be reached on 571-272-0629. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Renee Claytor

/SREENI PADMANABHAN/
Supervisory Patent Examiner, Art Unit 1627